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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,974	07/09/2002	Holger Rauth	100564-00106	9408
6449	7590	05/05/2005	EXAMINER	
ROTHWELL, FIGG, ERNST & MANBECK, P.C. 1425 K STREET, N.W. SUITE 800 WASHINGTON, DC 20005			MCINTOSH III, TRAVISS C	
			ART UNIT	PAPER NUMBER
			1623	

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,974

Applicant(s)

RAUTH ET AL.

Examiner

Traviss C. McIntosh

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-71 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-69 is/are allowed.
- 6) ☒ Claim(s) 70 and 71 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____

DETAILED ACTION

The Amendment filed January 4, 2005 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 45, 59, 63-65, and 68-69 have been amended.

Claims 72-89 have been canceled.

Remarks drawn to rejections of Office Action mailed October 5, 2004 include:

112 2nd paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

102(b) rejection: which have been overcome in part by applicant's amendments and have been withdrawn in part.

103(a) rejection: which have been overcome by applicant's amendments and have been withdrawn.

An action on the merits of claims 45-71 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 4, 2005 has been entered.

Claim Rejections - 35 USC § 102

Claims 70 and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawkins (US Patent 5,705,628) for the same reasons as claims 25-26 were in the previous office action.

Claim 70 is drawn to a kit for binding nucleic acids to a solid phase comprising, a binding buffer which contains a salt and polyethylene glycol, and a solid phase which has hydrophobic and hydrophilic groups on its surface. Claim 71 adds an elution buffer to detach the nucleic acid from the surface and a washing buffer to separate the impurities to the kit of claim 70.

Hawkins teaches a kit for binding nucleic acids to a solid phase comprising the magnetic microparticles having hydrophobic and hydrophilic moieties and a binding buffer. Moreover, Hawkins teaches there can be additionally an elution buffer to detach the nucleic acid from the solid phase and a wash buffer for removing the impurities (column 8, line 53 – column 9, line 15).

Applicant's amended their claims to state that the hydrophobic groups bind nucleic acids and hydrophilic groups prevent agglomeration. However, it is noted that these are properties which are inherent to the compounds used, and since the particles of Hawkins comprise both hydrophobic and hydrophilic moieties, they must have inherently had those properties associated therewith. The kits of Hawkins are seen to anticipate the kits of the instant application.

Allowable Subject Matter

Claims 45-69 are allowed. The following is a statement of reasons for the indication of allowable subject matter: the prior art is not seen to teach or fairly suggest a method of binding nucleic acids to a solid phase wherein the solid phase comprises hydrophobic and hydrophilic moieties wherein nucleic acids are bound to the hydrophobic moieties and the hydrophilic moieties prevent agglomeration. The closest prior art is seen to be Hawkins et al., however Hawkins teaches the nucleic acids bind to the carboxyl moieties, which are hydrophilic.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

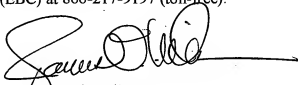
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Traviss C. McIntosh III
May 2, 2005



James O. Wilson
Supervisory Patent Examiner
Art Unit 1623